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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

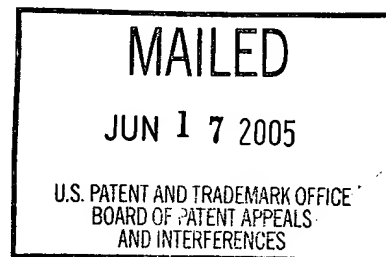
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS ANTHONY COFINO, STEPHEN H. GOMERY
JUHNYOUNG LEE and MARK EDWARD PODLASECK

Appeal No. 2005-0550
Application No. 09/654,202

ON BRIEF



Before JERRY SMITH, BARRY and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1 through 20. For the reasons stated *infra* we affirm the examiner's rejection of these claims.

The Invention

The invention relates to a method that provides visualizations of usage of a network from a log of network sessions. For each network session, shopping steps are identified and used to create a visualization of the session. See page 4 of appellants' specification.

Claim 1 is representative of the invention and is reproduced below:

A computer system for providing one or more visualizations to one or more users, the system comprising:

one or more central processing units, one or more memories, and one or more network interfaces to one or more networks;

a sessionization process that receives one or more Web server logs from one or more online stores, and generates one session table for each session found from requests recorded in Web server logs;

a shopping step finder process that receives one or more session tables, and generates one micro-conversion table for each given session table, each micro-conversion table comprising one or more shopping steps; and

a visualization process that receives one or more micro-conversion tables, and generates one or more micro-conversion visualizations of shopping steps from one or more of the micro-conversion tables.

References

The references relied upon by the examiner are:

Papierniak et al. (Papierniak)	6,175,838	Jan. 16, 2001 (filed April 29, 1998)
Hunt et al. (Hunt)	6,223,215	Apr. 24, 2001 (filed Sep. 22, 1998)
Yaginuma et al. (Yaginuma)	6,477,538	Nov. 5, 2002 (continuation of application filed Dec. 5, 1997)

Rejections at Issue

Claims 1 through 4, 8 through 11, 13 through 17, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Papierniak, in view of Yaginuma. Claims 5 through 7, 12 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Papierniak, in view of Yaginuma and Hunt. Claims 1 through 20 stand provisionally rejected under the judicially created doctrine of obvious type double patenting.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs, along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and examiner, for the reasons stated *infra*, we will not sustain the examiner's rejection of claims 1 through 20 under 35 U.S.C. § 103, however, we will sustain the examiner's provisional rejection of claims 1 through 20 under the judicially created doctrine of obvious type double patenting.

Appellants argue, on page 4 of the brief, that neither Yaginuma nor Papierniak teach or suggest shopping steps. Appellants assert:

Yaginuma is simply an apparatus for displaying the result of a data mining process as multi-dimensional data (see Abstract of Yaginuma). There is no teaching or suggestion that Yaginuma is used for tabulating or visualizing "shopping steps." Similarly, Papierniak is simply an apparatus that correlates Web page files (HTML, SHTML, DHTML, and CGI files) with other types of files (such as GIF, JPEG, and AVI files). See Abstract of Papierniak. There is no teaching or suggestion in Papierniak of generating tables having "shopping steps" or visualizations of "shopping steps," as claimed in independent claims 1, 19 and 20.

In response, the examiner states on page 6 of the answer:

[T]hese shopping sessions consist of recorded data as disclosed, claimed and argued are in the form of non-functional descriptive material (MPEP 2106). Moreover, non-functional descriptive material is given little patentable weight. In that regard, the shopping steps as taught by Papierniak are recorded for each session and thereby is recorded/stored data, which is considered to be non-functional descriptive material. This stored data in online methods and systems with specifics such as kind/type of recorded data (i.e. shopping steps) are given little patentable weight. The word(s) or phrase(s) are given little patentable weight because the claim limitation is considered to be non-functional descriptive material, which does not patentability distinguish the applicant's invention from Papierniak. Thereby, the non-functional descriptive material is directed only to the content of the data (i.e. shopping steps- which is stored data) and does not affect either the structure or method/process of Papierniak, which leaves the method and system unchanged.

Further, on page 7 of the answer the examiner states:

[T]he "shopping steps" are considered stored data and thereby the method and system of Yaginuma discloses a "data finder process" and that "the data finder process determines if there is a request that matches one of the axes of the parallel coordinate system and if there is a request that matches one of the axis of the parallel coordinate system and what value of the independent variable to be plotted on the respective axes" (citations omitted, emphasis original).

We concur with the appellants and disagree with the examiner that the limitation of a “shopping step” is non-functional descriptive material. Our reviewing court has said “[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.” *In re Gulack* 702 F.2d 1381, 1385, 217 USPQ 401,403 (Fed. Cir 1983). “The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *Id* at 404. However, in another case our reviewing court found that the printed matter rejection did not apply where the claims were directed to a data structure which “require specific electronic structural elements which impart a physical organization on the information stored in memory.” *In re Lowry* 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034 (Fed. Cir.1994). Claim 1 includes the limitation of a shopping step finder which generates micro-conversion table comprising one or more shopping steps and a visualization process that generates visualizations of the shopping steps. Independent claims 19 and 20 contain similar limitations. Appellants’ specification, on page 9, identifies that the “shopping step finder process” determines if there is a request in a web server log which matches one of the axis to be used in the visualization. One group of shopping steps, identified on page 10 of appellants’

specification includes product impression click-through, basket placement and purchase. Thus, the shopping steps are not the data, but rather a category by which the appellants' invention organizes the data, an electronic structural element that imparts organization to the data, and as such we consider it to be a functional limitation. See for example appellants' figure 4 which depicts a data entered into a web server log as compared to appellants' figure 6, which shows the data re-organized into several tables, the shopping steps are not data entries into the table but rather the criteria which define the structure of the table.

We find, as appellants argue, that Papierniak et al. teaches a system which correlates data records for web page files with other type files that are embedded in the web page file. See Abstract and column 3, lines 1-5. Papierniak teaches that the web pages included in the data records may be used by customers to gain information about products for sale and placing orders. See column 1, lines 40-44. However, we find no teaching or suggestion in Papierniak that the data in the web page files is categorized into shopping steps as claimed.

We find that Yaginuma teaches a method for displaying the result of a data mining process. See Abstract. Yaginuma teaches that user instructions for data mining are input, the instructions are pre-processed, the data mining is executed and the results are displayed. See figure 4 and description in column 5, lines 40-67. Figure 5 depicts an example of the target data to be data mined and figures 6 and 7 depicts examples of the data mining result display. We do not find that Yaginuma teaches a

generating micro-conversion table comprising one or more shopping steps as claimed in the "shopping step finder" limitation. As discussed *supra*, we consider a shopping step as a categorization of the data. While we note that the column headings in the target data, shown in figure 5, correspond to the data categories in visualizations, depicted in figures 6 and 7, we do not find that these column headings meet the claimed shopping steps as we find no teaching in Yaginuma that they are part of a generated micro-conversion table as claimed. Accordingly, we will not sustain the examiner's rejection of claims 1 through 4, 8 through 11, 13 through 17, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Papierniak, in view of Yaginuma.

We next consider the examiner's rejection of claims 5 through 7, 12 and 18 under 35 U.S.C. § 103 as being unpatentable over Papierniak, in view of Yaginuma and Hunt. Claims 5 through 7, 12 and 18 ultimately depend upon independent claim 1. As discussed *supra* we fail to find that the combination of Papierniak, and Yaginuma teach or suggest the limitations of claim 1. We do not find that Hunt teaches the limitations discussed above. Accordingly, we will not sustain the examiner's rejection of claims 5 through 7, 12 and 18 under 35 U.S.C. § 103.

We next consider the provisional rejection of claims 1 through 20 under the judicially created doctrine of obvious type double patenting. Appellants did not present any arguments directed to this rejection in the Brief. In the Reply Brief, appellants state that, with the Reply Brief a terminal disclaimer was filed to obviate this rejection. We note that a terminal disclaimer has been filed and is in the application file, however, as it


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was submitted after prosecution of the application was closed, the terminal disclaimer has not been evaluated by the Technology Center responsible for the case. Thus, the terminal disclaimer is not part of the appealed record. The examiner has not withdrawn the rejection and as such the rejection is before us on appeal. Accordingly, we sustain the examiner's rejection of these claims *pro-forma*.

In summary, we reverse the examiner's rejection of claims 1 through 20 under 35 U.S.C. § 103 and we sustain the examiner's provisional rejection of claims 1 through 20 under the judicially created doctrine of obvious type double patenting.

AFFIRMED

Jerry Smith
JERRY SMITH
Administrative Patent Judge


LANCE LEONARD BARRY
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES


ROBERT E. NAPPI
Administrative Patent Judge

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